

page 3.) Nonetheless, the Office Action concludes that the "unity or diversity of the particular elements or parts are not seen to comprise an inventive concept" and, therefore, has finally rejected Claims 1 and 3-5. Applicant respectfully disagrees.

Applicant has noted in previous responses to Office Actions that Claim 1 not only recites flexible vibration dampening means integrally formed with the sidewalls of the first structural member, but also expressly recites the following:

..., wherein the flexible vibration dampening means comprises a contoured portion of each of the first and second sidewalls of the first structural member, the contoured portion having a predetermined cross sectional shape to permit the sidewalls to flex, thereby absorbing at least a portion of the vibrational energy associated with traversing the surface.

Claim 1, as previously amended (emphasis added).

Applicant respectfully submits that Oyen et al. fail to teach or suggest a skate frame that includes:

1. flexible vibration dampening means integrally formed with the sidewalls of the first structural member;
2. wherein the flexible vibration dampening means comprises a contoured portion of the first and second sidewalls of the first structural member; and
3. the contoured portion having a predetermined cross-sectional shape to permit the sidewalls to flex.

Each of the foregoing are expressly recited in Claim 1 as it currently stands in the patent application. Applicant respectfully submits that Oyen et al. merely teach a skate frame having a plurality of discs, wherein the *discs*, and not the *sidewalls*, provide shock absorbing capacity to the wheels. Applicant also respectfully submits that there is no teaching or suggestion within Oyen et al. of flexible vibration dampening means that includes a contoured portion having a "predetermined cross-sectional shape to permit the *sidewalls* to flex," as generally set forth in Claim 1 (emphasis added).

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Moreover, applicant respectfully notes that Oyen et al. fail to teach or suggest flexible vibration means integrally formed with the sidewalls and, therefore, the rejection of Claim 1 under 35 U.S.C. § 102 is improper. As admitted in the final Office Action, Oyen et al. "fail to show the flexible vibration dampening means integrally formed with the sidewalls." (Final Office Action, page 3, emphasis added.) As is well known, to anticipate a claim, the reference must teach each and every element of the claim.¹ Applicant notes that the final Office Action cited multiple cases as the basis for supporting a rejection under 35 U.S.C. § 102. Applicant respectfully notes that each and every one of the cited cases address obviousness rejections under 35 U.S.C. § 103. Accordingly, because Oyen et al. fail to show flexible vibration dampening means integrally formed with the sidewalls, as generally set forth in Claim 1, and admitted by the final Office Action, applicant respectfully submits that the rejection of Claim 1 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

Even assuming that the rejection is proper under 35 U.S.C. § 102(b), applicant respectfully submits that the recitation of a flexible vibration dampening means integral with the sidewalls of the first structural member, as recited in Claim 1, is neither anticipated nor obvious in view of the prior art. It is well settled case law that merely combining multiple parts so as to constitute a unitary whole, which is integral, is obvious. *In re Larson, Russler, and Meldahl*, 144 U.S.P.Q. 347 (C.C.P.A. 1965). However, where "one piece has been made of two under circumstances where beneficial results admittedly are obtained and, in our opinion, bringing about these results required more than the exercise of mere mechanical skill," then the claim recitation of "integral" may result in patentability. *In re Otto and Heinrich*, 28 C.C.P.A. 1326,

¹ A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Company of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d, 1051, 1053 (Fed. Cir. 1987).

121 F.2d 553, 50 U.S.P.Q. 149, 150. Specifically, it is well settled that "integral" may be a patentable distinction where:

[s]omething more has been accomplished than merely making one piece out of two. One piece has been made of two under circumstances where beneficial results admittedly are obtained and, in our opinion, bringing about these results required more than the exercise of mere mechanical skill. It seems to us that in light of appellant's teaching, the structure of the sleeve itself has not only been improved, but its durability and ruggedness will result in a great saving in the life of belts used upon the device.

50 U.S.P.Q. at 150.

Like the similar circumstance in *In re Otto*, the skate frame of Claim 1 of the present application has several advantages over prior art skate frames. Specifically, flexible vibration dampening means integrally formed with the sidewalls "has no moving mechanical parts and, therefore, requires no maintenance or periodic replacement of worn or damaged parts." (Application as filed, page 4, lines 1-2.) Also, because the "skate frame of the present invention absorbs vibrational energy without mechanical parts, it requires no adjustments and is economical to produce." (Application as filed, page 4, lines 2-4.) Thus, "a vibrational dampening skate frame constructed in accordance with the present invention has several advantages over frames currently available in the art." (Application as filed, page 4, lines 4-6.)

Applicant further submits that not only is the embodiment of Claim 1 not anticipated by Oyen et al., but it is also non-obvious in view of Oyen et al. It is well known that for a proper rejection under 35 U.S.C. § 103, the Office Action must set forth a *prima facie* case of obviousness. However, there can be no *prima facie* case of obviousness if the proposed modification renders the prior art unsatisfactory for its untended purpose. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Also, a proposed modification cannot change a principle of operation of a reference. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349

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(C.C.P.A. 1959). Thus, a rejection under 35 U.S.C. § 103(a) is improper if a proposed modification either renders the prior art unsatisfactory for its untended purpose or changes a principle of operation of a reference.

Applicant respectfully submits that modifying Oyen et al. to include an integrally formed flexible vibration dampening means, as taught by applicant's own application, changes a principle of operation of Oyen et al., as well as renders it unsatisfactory for its intended purpose.

Oyen et al. disclose and claim that the "resilient shock absorbing mechanism" of its in-line roller skate is "removably located" in a cavity. Applicant notes that Oyen et al. in both the summary of the invention, as well as the detailed description of the preferred embodiments, recites the resilient members as being either replaceable or removable. Thus, an intended purpose of Oyen et al. is to provide a skate frame having removable or replaceable shock absorbing members. Also, operation of the skate frame of Oyen et al., includes removable resilient members.

Modifying Oyen et al., as suggested by applicant's own application, to include an integrally formed flexible vibration dampening means not only renders Oyen et al. unsatisfactory for its intended purpose of providing a skate frame with a removable resilient member, but also changes a principle of operation of Oyen et al. by eliminating the removable resilient member. Therefore, applicant respectfully submits that a rejection under 35 U.S.C. § 103 would be improper.

As a result, applicant respectfully submits that Oyen et al. fail to teach or suggest flexible vibration dampening means integrally formed with the sidewalls of the first structural member, and, therefore, Oyen et al., as well as the other cited references of record, cannot anticipate nor render obvious the embodiment of Claim 1. Applicant respectfully emphasizes that the

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embodiment of Claim 1 is not merely using "a one piece construction in place of a multiple piece assemblage," as asserted by the Office Action.

Rejections under 35 U.S.C. § 103

Claims 2-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyen et al. as applied to Claim 1, and further in view of U.S. Patent No. 5,092,614, issued to Malevicz. Applicant respectfully disagrees.

As noted above, Oyen et al. fail to teach or suggest a skate frame that includes a flexible vibration dampening means having a contoured portion of each of the first and second sidewalls of the skate frame, wherein the contoured portion includes a predetermined cross-sectional shape to permit the *sidewalls* to flex, as set forth in Claim 1. Instead, Oyen et al. merely teach a skate frame that includes a series of discs disposed within an opening formed in the sidewall to provide shock absorbing capabilities to the wheels of the skate frame. Thus, Oyen et al. fail to teach or suggest a skate frame that includes flexible vibration dampening means having a contoured portion defining a predetermined cross-sectional shape to permit sidewalls to flex. Malevicz fails to address, and, therefore, cannot overcome the foregoing shortcomings of Oyen et al.

Malevicz teaches a skate frame that includes front and rear mounting surfaces 200, 204, 210, and 214 that *resist side-to-side flexing* of the skate frame. Col. 11, lines 30-32 (emphasis added). Additionally, Malevicz *expressly* teaches that the skate frame, which includes the curved portions 130 and 160, provides a more stable structure than prior art because "they *resist* lateral twisting and *flexing*" better than prior art frames. Col. 11, lines 35-39 (emphasis added). Thus, Malevicz teaches an in-line skate frame that includes a curved portion to *resist* flexing. This is not the embodiments of Claims 3-5. Thus, a hypothetical combination of Oyen et al. and Malevicz fails to teach or suggest the embodiments of Claims 3-5.

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Allowed Subject Matter

Claims 14-21, 24, 25, 27, and 29-34 were noted as allowed. Applicant thanks the Examiner for this notice of allowed claims.

Allowable Subject Matter

Claims 6-13 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant acknowledges and thanks the Examiner for this notice of allowable subject matter.

CONCLUSION

In light of the foregoing remarks, applicant respectfully submits that the present application is now in condition for allowance. Applicant respectfully requests reconsideration and allowance of all claims. The Examiner is invited to telephone the undersigned attorney if there are any remaining issues.

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: December 2, 2003



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